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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,550	05/31/2000	Lee Benzinger	NA11P002/00.056.01	5992
28875	7590	07/28/2006	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 07/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/586,550		BENZINGER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dan Kesack		3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9,11-17,19-23 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,11-17,19-23 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/12/2006</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Amendment filed May 10, 2006 has been entered and fully considered. Original claims 3-5, 7, 13-17, amended claims 1, 2, 6, 9, 11, 12, 19-23, and new claims 26-29 are currently pending. Claims 8, 10, 18, 24 and 25 have been cancelled.

### ***Specification***

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. *Vas-Cat, Inc. v. Mahurkar*, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims.

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Specifically, on page 6, Applicant discloses the contract criteria being based on a cost model. Lines 23-29 detail what the cost model may be based on, but is not enabling to one of ordinary skill in the art because it does not define what a cost model is, or in what way such a model may "relate" to the various factors disclosed. Without a disclosure of what the cost model is, one cannot determine on what the criteria of the contract is to be based.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-7, 11, 14-17, and 20 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-7, 9, 11-17, 19-23, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kase et al., U.S. Patent No. 6,182,055.

Claims 1, 9, 11, 19, 20, Kase discloses a method and apparatus for conducting negotiations over a network according to criteria, comprising:

governing an interaction between a plurality of components of a system utilizing the criteria of a contract, the components including a module subject to the governing (column 3 line 52 – column 4 line 26);

determining whether the interaction between components meet the criteria of the contract (column 12 line 54 – column 13 line 3);

adapting interaction between the components of the system upon the criteria not being met (column 14 lines 1-17, 36-47);

wherein the contract is created by advertising a capability to a control which handles contract negotiations (column 13 lines 52-61), accepting the proposed contract, receiving a seal message (column 14 lines 29-35), receiving and storing a fallback proposed contract and replacing the proposed contract with the fallback proposed contract, if required (column 15 lines 13-28, column 18 lines 18-27);

wherein the proposed contract is selected from a predetermined set (column 13 lines 42-51); and,

wherein it is determined that replacement of the proposed contract is required when the interaction governed by the proposed contract no longer meets criteria of a cost model (column 18 lines 18-27).

Claims 1, 9, 11, 19, 20, Kase fails to teach the interaction being a security-related interaction, and a component including an intrusion detection module. Kase discloses that the field and content to which the invention is applied is non-limiting, and the invention can be applied to other fields. These limitations are interpreted by the Examiner to be intended use limitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, the system and method disclosed in Kase is capable of performing dynamic adaptation of a system in accordance with criteria, regardless of the system's field of use.

Claims 2, 3, 12, 13, Kase teaches interaction between components is adapted by adjusting the contract, wherein the contract is adjusted by modifying a contract and activating a different contract (column 15 lines 13-28, column 18 lines 18-27).

Claims 4-7, 14-17, Kase teaches the contract including a cost model criteria, wherein the cost model criteria is interpreted to mean criteria based on at least resource

utilization, amount of load on a system, performance, or provisioning of service (column 3 line 52 – column 4 line 26).

Claim 21, Kase teaches a method and apparatus for conducting negotiations over a network according to criteria, comprising:

governing an interaction between a plurality of components of a system utilizing the criteria of a contract, the components including a module subject to the governing (column 3 line 52 – column 4 line 26);

determining whether the interaction between components meet the criteria of the contract (column 12 line 54 – column 13 line 3);

adapting interaction between the components of the system upon the criteria not being met (column 14 lines 1-17, 36-47);

wherein interaction between components is adapted by adjusting the contract, wherein the contract is adjusted by modifying a contract and activating a different contract (column 15 lines 13-28, column 18 lines 18-27);

wherein the contract is created by advertising a capability to a control which handles contract negotiations (column 13 lines 52-61), accepting the proposed contract, receiving a seal message (column 14 lines 29-35), receiving and storing a fallback proposed contract and replacing the proposed contract with the fallback proposed contract, if required (column 15 lines 13-28, column 18 lines 18-27);

wherein the proposed contract is selected from a predetermined set (column 13 lines 42-51); and,

wherein it is determined that replacement of the proposed contract is required when the interaction governed by the proposed contract no longer meets criteria of a cost model (column 18 lines 18-27).

Claim 22, 23, Kase teaches the modules are adapted for communicating information between modules (column 11 lines 40-54).

Claim 26, Kase teaches the control component selects the contract from the predetermined set of contracts (column 13 lines 42-51).

Claim 27, Kase teaches the interaction is prohibited if the proposed contract is not accepted (column 16 lines 43-55).

Claim 28, Kase teaches another seal message is received from the control component for completing the fallback proposed contract (column 18 lines 18-35).

Claim 29, Kase teaches the fallback proposed contract is stored, but not activated, before the completion, for use in case the replacement is required (column 15 lines 13-28, column 18 lines 18-27).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600